

1 Remarks

2 The application being filed herewith is a continuation application of co-pending
3 U.S. Patent Application Serial No. 10/147,251, filed May 15, 2002 ("the Parent
4 Application").

5
6 Amendments to the specification

7 The specification filed herewith is to be amended as set forth above.
8 Specifically, a "Cross Reference to Related Applications" section is to be added at
9 page 1 to assert the continuation status of the application, as set forth above.

10 The specification filed herewith has also been amended to replace the
11 incorrect title at page 1, line 1 (originally, "Methods and Apparatus") with the correct
12 title, "Imaging Apparatus and Methods" (which is found on the cover sheet). The
13 specification was amended in the Parent Application to correct this defect.

14 No new matter has been added to the specification.

15
16 Amendments to the claims

17 Claim 1 has been amended as indicated above. Support for the amendment
18 to claim 1 is found in the specification at page 4 lines 6-8.

19 Claim 2 has been amended so that it is consistent with amended claim 1.

20
21 Previous Rejection of Claims under 35 U.S.C. § 102

22 In the Parent Application, in an Office action dated April 21, 2003: (1) claims
23 1-3, 5 and 6 were rejected under 35 U.S.C. § 102 as being anticipated by U.S.
24 Patent No. 5,076,562 ("Sai et al."); (2) claims 7-11 were rejected under 35 U.S.C. §
25 102 as being anticipated by Japanese Patent No. JP 03143845A ("Hayashi"); and
(3) claims 23-24 were rejected under 35 U.S.C. § 102 as being anticipated by U.S.
Patent No. 5,102,112 ("Takahashi").

1 Each of the three separate 35 U.S.C. § 102 rejections of claims 1-3, 5-11 and
2 23-24 will be addressed below.

3 As a starting point, the PTO and the Federal Circuit provide that §102
4 anticipation requires each and every element of the claimed invention to be
5 disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d
6 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited
7 §102 reference of any claimed element negates the anticipation. (*Kloster*
8 *Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.
9 1986)). Furthermore, “[a]nticipation requires that all of the elements and limitations
10 of the claims are found within a single prior art reference.” (*Scripps Clinic and*
11 *Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010
12 (Fed. Cir. 1991 (emphasis added)). Moreover, the PTO and the Federal Circuit
13 provide that §102 anticipation requires that there must be no difference between the
14 claimed invention and the reference disclosure. (*Scripps Clinic and Research Found.*
15 *v. Genetech, Inc.*, *id.* (emphasis added)). Accordingly, if the Applicant can
16 demonstrate that any one element or limitation in the rejected claim(s) is not
17 disclosed by the cited reference, then the respective claim(s) must be allowed.

18
19 Claims 1-3 and 5-6

20 The Applicant respectfully disagrees that claims 1-3 and 5-6 are anticipated
21 by Sai et al.

22 Claim 1, as amended, includes the following limitation:

23
24 wherein the first media tray is configured to slide relative to the
25 second media tray to facilitate selective presentation of the first imaging
media and the second imaging media, one-at-a-time, to the pick roller for
picking [emphasis added]

1 As can be seen by comparing Figs. 3 and 4 of Sai et al., the paper trays 40A
2 and 40B of Sai et al. do not slide relative to one another (as is required by
3 Applicant's claim 1), but rather slide in unison with one another. Sai et al. do not
4 teach or suggest the two paper trays sliding relative to one another, as is required by
5 applicant's claim 1.

6 For at least this reason the Applicant contends that claim 1 is novel over Sai
7 et al. Claims 2, 3, 5 and 6 depend from claim 1, either directly or indirectly, and
8 therefore inherently contain the limitations of claim 1. It is axiomatic that any claim
9 which depends from an allowable base claim is also allowable. Accordingly, claims
10 2, 3, 5 and 6 are also allowable over Sai et al. The Applicant therefore requests that
11 the rejection of claims 1-3 and 5-6 be removed and the claims allowed.

12
13 Claims 7-11

14 The Applicant respectfully disagrees that claims 7-11 are anticipated by
15 Hayashi.

16 Claim 7 includes the following limitations:

17
18 a second media tray configured to hold a second imaging
19 media, wherein the first media tray is slidably disposed upon the
20 second media tray; and,

21 a pick roller, wherein the first media tray is configured to slide
22 relative to the second media tray to facilitate selective presentation of
23 the first imaging media and the second imaging media, one-at-a-time, to
24 the pick roller for picking. (Emphasis added)

25
(Continued on next page.)

1 As can be seen by viewing Fig. 4 of Hayashi, the first media tray 15a is not
2 slidably disposed upon the second media tray 15b (as is required by Applicant's
3 claim 7), but rather are disposed in a side-by-side relationship, and slide in unison
4 with one another. Hayashi does not teach or suggest a first media tray slidably
5 disposed upon a second media tray, as is required by applicant's claim 7.

6 For at least this reason the Applicant contends that claim 7 is novel over
7 Hayashi. Claims 8-11 depend from claim 7, either directly or indirectly, and therefore
8 inherently contain the limitations of claim 7. It is axiomatic that any claim which
9 depends from an allowable base claim is also allowable. Accordingly, claims 8-11
10 are also allowable over Hayashi. The Applicant therefore requests that the rejection
11 of claims 7-11 be removed and the claims allowed.

12 13 Claims 23-24

14 Claims 23-24 have been cancelled, and therefore the rejection of these claims
15 as being anticipated by Takahashi is now moot.

16 17 Previous Rejection of Claims under 35 U.S.C. § 103

18 In the Parent Application, in an Office action dated April 21, 2003, claim 4 was
19 rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,076,562
20 ("Sai et al.") in view of U.S. Patent No. 5,102,112 ("Takahashi").

21 The Applicant respectfully disagrees that claim 4 is obvious over Sai et al. in
22 view of Takahashi.

23 As a starting point, M.P.E.P. §2143.03 states that "All Claim Limitations Must
24 Be Taught or Suggested" [by the prior art] to sustain a rejection under §103.
25 (Emphasis added).

1 Claim 4 depends from claim 1, and therefore includes the limitations of
2 claim 1. As explained above, claim 1 (as amended) includes the following limitation:

3
4 wherein the first media tray is configured to slide relative to the
5 second media tray to facilitate selective presentation of the first imaging
6 media and the second imaging media, one-at-a-time, to the pick roller for
7 picking [emphasis added]
8

9 Neither Sai et al. nor Takahashi teach or suggest a first media tray configured to
10 slide relative to the second media tray to facilitate selective presentation of a first
11 imaging media and a second imaging media, one-at-a-time, to a pick roller for picking,
12 as is inherently required by Applicant's claim 4 (by virtue of its dependency from
13 claim 1).

14 For at least this reason, the Applicant contends that claim 4 is not anticipated
15 by Sai et al. in view of Takahashi, and that claim 4 is therefore allowable. The
16 Applicant therefore requests that the rejection of claim 4 as being obvious over Sai
17 et al. in view of Takahashi be removed and the claim allowed.
18

19 New claims 25-30

20 Support for new claims 25-30 is found in: original (now cancelled)
21 claims 23-24, the specification at page 4 lines 6-8, and Figs. 3-9.
22

23 Summary

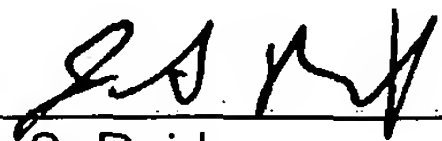
24 The Applicant believes that this Preliminary Amendment addresses each and
25 every rejection of the claims in the Office action dated April 21, 2003, and therefore
requests timely allowance of claims 1-11 and 25-30.

1 The Examiner is respectfully requested to contact the below-signed
2 representative if the Examiner believes this will facilitate issuance of allowance of claims
3 1-11 and 25-30.
4

5 Respectfully submitted,

6 Eric Unger ESKEY

7 Date: July 30, 2003

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